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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/592,461 06/09/00 FLESZEWSKI

V RRE-P-00-001

023560 WM01/1207
PATENTS & TMS, P.C.
1914 NORTH MILWAUKEE AVENUE
CHICAGO IL 60647

EXAMINER

SMITH, T	
ART UNIT	PAPER NUMBER

2641
DATE MAILED:

12/07/00

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

TS

Office Action Summary

Application No.
09/592,461

Applicant
Michael J. Novosel, Jr., et al.

Examiner
Tallvaldis Ivars Smits

Group Art Unit
2641



☒ Responsive to communication(s) filed on Jun 9, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

- ☒ Claim(s) 1-50 is/are pending in the application.
- Of the above, claim(s) _____ is/are withdrawn from consideration.
- ☒ Claim(s) 1-20 is/are allowed.
- ☒ Claim(s) 21-50 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claims _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☒ The proposed drawing correction, filed on Jun 9, 2000 is ☒ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☒ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) _____.
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- ☐ Notice of References Cited, PTO-892
- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

DETAILED ACTION

Reissue Applications

1. Applicants have filed for a reissue of U.S. Patent 5,855,104, issued on December 29, 1998 based on application 08/851,200 filed May 5, 1997, which, in turn, was filed as a CIP of abandoned application 08/289,257 filed August 11, 1994. Applicants have amended typographical errors found in the original Specification, Drawings, and claims, and have also added new claims 21-50.

Drawings

2. The proposed drawing corrections (to Figures 5A, 6, 7C, 8C, and 9C), filed on June 9, 2000, have all been approved.

Oath/Declaration

3. The reissue oath/declaration filed with this application is defective because it fails to identify at least one specific error which is relied upon to support the reissue application. See 37 CFR 1.175(a)(1) and MPEP § 1414.

The "error" listed in the declaration by applicants' general statement that "I failed to include claims broader in scope than that which issued in independent Claim 1", is too vague and indefinite. Applicant should specifically indicate how the sole independent claim was unnecessarily narrowed.

Allowable Subject Matter

4. Claims 1-20 are allowed over the prior art of record reasons given in paragraph 6 of Paper No. 4 of the parent (CIP) application 08/851,200.

Specifically, the sole independent claim 1 of the CIP application was allowed because “it recites storing at predetermined addresses in an analog memory contained in a model train a plurality of sound effects, controlled by an integrated analog-sound/motor/special-effects controller which uses bi-polar digital signal packets to, *inter alia*, recall for playback said analog sounds effects from said memory in a predetermined or a random sequence, when the corresponding digital packet triggers its sound effect”. And, dependent claims 2-20 were allowed because they further limit claim 1 or their parent claims.

5. The above-mentioned (combination) limitation of an integrated analog-sound/motor/special-effects controller using bi-polar digital signal packets to play stored analog sound effects in a predetermined or random sequence from predetermined addresses was added to claim 1 of the original application 08/289,257 when amending it for the CIP. Thus, it was originally **presented/argued/stated** in the parent application to make the claims allowable over the Final Rejection made to the original application

Claim Rejections - 35 USC § 251

6. New claims 21-50 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

The nature of the defect(s) in the declaration is set forth in the discussion above, under **Oath/Declaration**, and further explained next, in this Office Action.

7. New claims 21-50 are rejected under 35 U.S.C. 251 as being an improper recapture of claimed subject matter deliberately surrendered in the application for the patent upon which the present reissue is based. *See Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ289, 295 (Fed. Cir. 1984).

Neither the sole new independent claim 21, nor dependent claims 22-50 include **all** of the (combination) limitations, cited in the reasons for allowance under **Allowable Subject Matter**, above, which made the CIP application allowable.

Therefore, since the limitation now being omitted or broadened in the present reissue was originally **presented/argued/stated** in the original application to make the claims allowable over the Final Rejection made to the original application, the omitted limitation relates to subject matter previously **surrendered** by applicant, and impermissible **recapture** exists.

Accordingly, the narrow scope of claim 1 in the patent was not an "error" within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

Conclusion

8. **Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or FAXed to:

(703) 305-9508 or 308-6306 or 308-6296 (for informal or draft communications, please label "PROPOSED" or "DRAFT"; for formal communications, please label "OFFICIAL")

Hand-delivered responses should be brought to Crystal Park 2, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

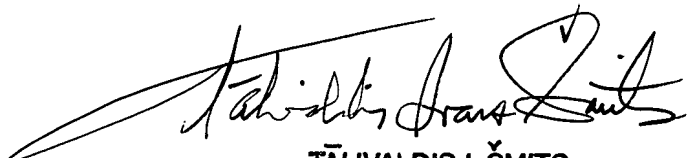
9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to the examiner, Talivaldis Ivars Smits, whose telephone number is (703) 306-3011. The examiner can normally be reached Mondays-Fridays from 8:30 a.m. to 5:00 p.m.

As of October 2, 2000 the former Technology Center 2700 has been split into two centers (TC 2100 and TC 2600), and former Art Unit 2741 has been designated as **Art Unit 2641**, which new AU number should be used in all future correspondence.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David R. Hudspeth, can be reached on (703) 308-4825. The facsimile phone numbers for Technology Center 2600 are (703) 305-9508; (703) 308-6306; and (703) 308-6296.

Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center 2600 receptionist, whose telephone number is (703) 305-3900

Art Unit 2641
November 30, 2000



TĀLIVALDIS I. ŠMITS
PATENT EXAMINER